



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,618	06/13/2000	Jay S. Walker	00-012	5604

22927 7590 11/02/2006

WALKER DIGITAL
2 HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,618

Applicant(s)

WALKER ET AL.

Examiner

Igor Borissov

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/27/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-28, 30-53, 59-64 and 81-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-28, 30-53, 59-64 and 81-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 7/27/2006 is acknowledged and entered. Claims 13, 29, 54-58, 65-80 have been canceled. Claims 1, 30, 47, 49, 51-53, 59, 63, 64, 81, 85, 86 have been amended. New claims 88-108 have been added. Claims 1-12, 14-28, 30-53, 59-64 and 81-108 are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-9, 11-12, 14-25, 28, 30-33, 35-38, 40-44, 46-53, 88-103 and 106-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US 2002/0049631).

Williams teaches a computer-implemented method, system and computer-readable medium having computer-readable instruction for causing said computer to implement said method for providing purchasing incentives to a plurality of retail store environments, comprising:

Independent Claims

As per claims 1, 88 and 89,

- receiving information relating to a first transaction, the first transaction been associated with a first price [0025] (Williams teaches that examples of classes of individuals whom may be offered an electronic incentive include customers *who make in excess of a specified amount of purchases* from a specific retailer or *by using a specified credit card each month* [0025], thereby indicating conducting at least a first transaction to achieve said specified amount of purchases or during a first month of

Art Unit: 3639

using said specified credit card; and, accordingly, a first price during said first transaction);

- determining a benefit, said benefit based at least in part on said information [0038];

- determining a price of said benefit, wherein said price is non-zero monetary amount [0038];

- charging the price to a customer associated with the first transaction [0025] (conducting said qualified purchases) [0013];

- applying said benefit during a second transaction [0063].

Williams does not explicitly teach that said determined price of said benefit is different than the first transaction price.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that said benefit is different than the transaction price, because, based on common sense, there are only two choices available here, during the step of determining said price for said benefit. Said price is either equal to the transaction price, or different, and either choice is in the range of skill to arrive to for one of ordinary skill in the art.

As per claims 30, 90 and 91,

- receiving transaction information, the transaction information been associated with a transaction having a transaction price [0020];

- determining a benefit and a qualifying action for said benefit, said benefit based at least in part on said information [0020]; [0038];

- determining a price for said benefit, wherein said price is a non-zero monetary amount [0038];

- selling said benefit at said price to a customer (the customer qualifies for the benefit by having made qualified purchases) [0013];

- applying said benefit during a second transaction [0063].

Williams does not explicitly teach that said determined price of said benefit is different than the transaction price.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that said benefit is different than the transaction price, because, based on common sense, there are only two choices available here, during the step of determining said price for said benefit. Said price is either equal to the transaction price, or different, and either choice is in the range of skill to arrive to for one of ordinary skill in the art.

As per claims 47, 49, 92-95,

- conducting a transaction for a purchase of a first service, the purchase been associated with a transaction price [0020];
- determining a benefit during said transaction, said benefit associated with a future purchase of a second service and said benefit having an associated benefit price, wherein said benefit price is a non-zero monetary amount [0020]; [0038];
- providing to a customer said benefit at said price during said transaction, thereby charging the price to the consumer (the customer qualifies for the benefit by having made qualified purchases) [0013];
- applying said benefit during a second transaction [0063].

Williams does not explicitly teach that said determined price of said benefit is different than the transaction price.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that said benefit is different than the transaction price, because, based on common sense, there are only two choices available here, during the step of determining said price for said benefit. Said price is either equal to the transaction price, or different, and either choice is in the range of skill to arrive to for one of ordinary skill in the art.

As per claims 51, 52, 96-99,

- receiving information relating to a first transaction, the first transaction been associated with a first transaction price [0020];

- determining a benefit, said benefit based at least in part on said information and having an associated price, wherein said price is a non-zero monetary amount [0013]; [0020]; [0038];

- providing, to a customer associated with the first transaction, said benefit at said price during said transaction, thereby charging the price to the consumer (the customer qualifies for the benefit by having made qualified purchases) [0013];

- applying said benefit during a second transaction, wherein said benefit is applicable by the customer during said second transaction only if said customer has completed a qualifying action associated with said benefit [0063].

Williams does not explicitly teach that said determined price of said benefit is different than the transaction price.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that said benefit is different than the transaction price, because, based on common sense, there are only two choices available here, during the step of determining said price for said benefit. Said price is either equal to the transaction price, or different, and either choice is in the range of skill to arrive to for one of ordinary skill in the art.

As per claims 53, 100 and 101,

- receiving information associated with a first transaction, the first transaction been associated with a first transaction price [0020];

- establishing a benefit having a first price, wherein said first price is non-zero monetary amount [0038];

- selling, to a customer associated with the first transaction, said benefit for said first price during said first transaction, thereby charging said price to the customer (the customer qualifies for the benefit by having made qualified purchases) [0013];

- applying said benefit during a second transaction [0063].

Williams does not explicitly teach that said determined first price of said benefit is different than the transaction price.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that said benefit is different than the transaction price, because, based on common sense, there are only two choices available here, during the step of determining said price for said benefit. Said price is either equal to the transaction price, or different, and either choice is in the range of skill to arrive to for one of ordinary skill in the art.

Dependent Claims

Furthermore, Williams teaches,

As per claims 2 and 32, said method, further comprising at least one of the following: retrieving benefit information; offering said benefit for sale at said price; receiving an indication of a purchase of said benefit; and receiving an indication of a customer's agreement to purchase said benefit [0037] - [0039].

As per claims 3 and 33, said method, further comprising at least one of the following: determining an available subsidy; receiving a subsidy amount; and determining a margin between a price and a subsidy amount [0040]; [0051]; [0052].

As per claims 4 and 31, said method, further comprising:

- verifying usability of said benefit during said second transaction [0020] - [0022]; [0037] - [0039].

As per claims 6 and 35, said method, further comprising at least one of the following: establishing a condition on said benefit; determining a condition associated with said benefit; and providing an indication of a condition associated with said benefit [0020] - [0022].

As per claims 7 and 36, said method, further comprising at least one of the following: receiving an indication of a receiver of said benefit; canceling said benefit; changing said benefit; and redeeming said benefit [0020] - [0022].

As per claims 8 and 37, said method, further comprising at least one of the following: receiving a customer identifier; receiving a group identifier; receiving a customer device identifier; receiving a payment identifier; receiving a retailer identifier;

Art Unit: 3639

receiving a benefit identifier; receiving a service identifier; and receiving a product identifier [0031] - [0035].

As per claims 9 and 38, said method, further comprising at least one of the following: redeeming a previously determined benefit; receiving a request to redeem said benefit; aggregating said benefit with a previously determined benefit [0006]; [0019]; [0022].

As per claims 11-12 and 40, providing a list of at least two benefits; receiving an indication of a selection of one of said at least two benefits; receiving an indication of at least one person to whom said benefit is to be provided [0037] - [0039].

As per claims 13, 19, 20-22, 46, 48 and 50, see reasoning applied for claims 1, 30, 49 and 86.

As per claims 14, 15 and 41, associating a qualifying action (purchasing an identified product) with said benefit [0020]; [0038].

As per claims 16-17 and 42-44,
receiving an indication of a completion of said qualifying action [0024]; [0038];
providing said benefit after receiving said indication [0024]; [0038];
arranging for said benefit to be provided after receiving said indication [0024]; [0038].

As per claim 18, said method, wherein said transaction information includes a customer identifier [0037].

As per claim 23, said method, wherein said benefit is a previously determined benefit [0039].

As per claims 24 and 25, providing a receipt (coupon) to a customer, wherein said receipt includes a benefit identifier [0022].

As per claim 28, said method, wherein said benefit cannot be applied during said first transaction [0022].

As per claims 106 and 107, it is old and well known to use mobile terminal for e-commerce. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that the customer

device is mobile terminal, because it would advantageously allow customers to conduct shopping at any convenient for the customers place and time.

Claims 59-64, 81-87, 102-105 and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Nilssen (US 6,017,063).

Independent Claims

As per claims 59, 102 and 103, Williams teaches:

- determining at least one product being purchased by a customer during a first transaction [0020]; [0038];
- determining a price for said at least one product being purchased during said first transaction [0020]; [0038];
- offering said customer an opportunity to purchase said at least one product during a second transaction at said price [0020]; [0038];
- receiving an acceptance of said offer from the consumer by receiving a payment for the opportunity (the customer qualifies for the benefit by having made qualified purchases; conducting qualified purchases by the customer indicates the acceptance of said offer by the consumer) [0013];
- applying said benefit during a second transaction [0063].

Williams does not specifically teach that said benefit comprises allowing said customer to purchase said product during said second transaction for said (first transaction) price.

Nilssen teaches a method and system for a financial certificates, wherein a financial coded certificates denominated in pricing units (first transaction price) of a product is sold to a customer; said certificate represents a certain amount or a certain number of merchandise units; which amount of merchandise will be delivered to the bearer of the certificate in exchange therefor. Specifically, the holder of such a certificate is entitled to exchange this certificate, at any later time, for said product *equivalent in total pricing units to the denomination specified on the certificate* (said first

Art Unit: 3639

transaction price), regardless of any intervening changes in dollar pricing of said product (C. 1, L. 42-46; C. 2, L. 44-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that said benefit comprises allowing said customer to purchase said product during said second transaction for said (first transaction) price, as disclosed in Nilssen, because it would advantageously allow customer to obtain said product in the future at the same price regardless of inflation (Nilssen, C. 1, L. 39-40).

Williams Nilssen does not explicitly teach that said determined first price of said benefit is different than the transaction price.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams and Nilssen to include that said benefit is different than the transaction price, because, based on common sense, there is only two options available during the step of determining said price for said benefit, it is either equal to the transaction price, or different.

As per claims 63, 64, 104 and 105,

- determining at least one product being purchased by a customer during a first transaction [0020]; [0038];
- determining a price for said at least one product being purchased during said first transaction [0020]; [0038];
- determining a benefit and a value of said benefit [0020]; [0038];
- providing said customer a benefit during said first transaction, wherein said benefit allows to purchase said at least one product during a second transaction at said price [0020]; [0038];
- charging said customer for a cost of the benefit (the customer qualifies for the benefit by having made qualified purchases; conducting qualified purchases by the customer indicates the acceptance of said offer by the consumer) [0013];
- applying said benefit during a second transaction [0063].

Art Unit: 3639

Williams does not specifically teach that said benefit comprises allowing said customer to purchase said product during said second transaction for said (first transaction) price.

Nilssen teaches a method and system for a financial certificates, wherein a financial coded certificates denominated in pricing units (first transaction price) of a product is sold to a customer; said certificate represents a certain amount or a certain number of merchandise units; which amount of merchandise will be delivered to the bearer of the certificate in exchange therefor. Specifically, the holder of such a certificate is entitled to exchange this certificate, at any later time, for said product *equivalent in total pricing units to the denomination specified on the certificate* (said first transaction price), regardless of any intervening changes in dollar pricing of said product (C. 1, L. 42-46; C. 2, L. 44-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that said benefit comprises allowing said customer to purchase said product during said second transaction for said (first transaction) price, as disclosed in Nilssen, because it would advantageously allow customer to obtain said product in the future at the same price regardless of inflation (Nilssen, C. 1, L. 39-40).

As per claim 81, Williams teaches:

- determining a first price for which a product (a unit of a product) is being purchased as a part of a first transaction at a point of sale terminal [0020]; [0038];
- determining a benefit for the future second transaction [0013]; [0020];
- outputting, at the point of sale terminal, an offer to sell the benefit for a second price [0020]; [0038];
- charging a customer for a cost of the benefit (the customer qualifies for the benefit by having made qualified purchases; conducting qualified purchases by the customer indicates the acceptance of said offer by the consumer) [0013].

Williams does not specifically teach that said benefit comprises a guarantee that no more than the first price for a second unit of the product will be charged if the second unit of the product is purchased as part of a second transaction.

Nilssen teaches a method and system for a financial certificates, wherein a financial coded certificates denominated in pricing units of a product is sold to a customer; said certificate represents a certain amount or a certain number of merchandise units; which amount of merchandise will be delivered to the bearer of the certificate in exchange therefor. Specifically, the holder of such a certificate is entitled to exchange this certificate, at any later time, for said product equivalent in total pricing units to the denomination specified on the certificate, regardless of any intervening changes in dollar pricing of said product (C. 1, L. 42-46; C. 2, L. 44-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that said benefit comprises a guarantee that no more than the first price for a second unit of the product will be charged if the second unit of the product is purchased as part of a second transaction, as disclosed in Nilssen, because it would advantageously allow customer to obtain said product in the future at the same price regardless of inflation (Nilssen, C. 1, L. 39-40).

As per claims 85 and 86, Williams teaches:

- determining a purchase total for a first transaction including a plurality of products [0020]; [0038];
- determining a benefit for the future second transaction [0013]; [0020];
- outputting, at the point of sale terminal, an offer to sell the benefit for a price [0020]; [0038];
- charging a customer for a cost of the benefit (the customer qualifies for the benefit by having made qualified purchases; conducting qualified purchases by the customer indicates the acceptance of said offer by the consumer) [0013].

Williams does not specifically teach that said benefit comprises a guarantee that an amount that is not greater than the purchase total will be charged for the plurality of products during a second transaction.

Nilssen teaches a method and system for a financial certificates, wherein a financial coded certificates denominated in pricing units of a product is sold to a customer; said certificate represents a certain amount or a certain number of merchandise units; which amount of merchandise will be delivered to the bearer of the certificate in exchange therefor. Specifically, the holder of such a certificate is entitled to exchange this certificate, at any later time, for said product equivalent in total pricing units to the denomination specified on the certificate, regardless of any intervening changes in dollar pricing of said product (C. 1, L. 42-46; C. 2, L. 44-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that an amount that is not greater than the purchase total will be charged for the plurality of products during a second transaction, as disclosed in Nilssen, because it would advantageously allow customer to obtain said product in the future at the same price regardless of inflation (Nilssen, C. 1, L. 39-40).

As per claim 108,

- determining at least one product being purchased by a customer during a first transaction [0020]; [0038];
- determining a price for said at least one product being purchased during said first transaction [0020]; [0038];
- providing said customer a benefit during said first transaction, wherein said benefit allows to purchase said at least one product during a second transaction at said price [0020]; [0038];
- charging said customer for the benefit (the customer qualifies for the benefit by having made qualified purchases; conducting qualified purchases by the customer indicates the acceptance of said offer by the consumer) [0013];

Williams does not explicitly teach that said charged price for said benefit is different than the first transaction price.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that said benefit is different

Art Unit: 3639

than the transaction price, because, based on common sense, there are only two choices available here, during the step of determining said price for said benefit. Said price is either equal to the transaction price, or different, and either choice is in the range of skill to arrive to for one of ordinary skill in the art.

Williams, also, does not specifically teach that said benefit comprises allowing said customer to purchase said product during said second transaction for said (first transaction) price.

Nilssen teaches a method and system for a financial certificates, wherein a financial coded certificates denominated in pricing units (first transaction price) of a product is sold to a customer; said certificate represents a certain amount or a certain number of merchandise units; which amount of merchandise will be delivered to the bearer of the certificate in exchange therefor. Specifically, the holder of such a certificate is entitled to exchange this certificate, at any later time, for said product *equivalent in total pricing units to the denomination specified on the certificate* (said first transaction price), regardless of any intervening changes in dollar pricing of said product (C. 1, L. 42-46; C. 2, L. 44-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that said benefit comprises allowing said customer to purchase said product during said second transaction for said (first transaction) price, as disclosed in Nilssen, because it would advantageously allow customer to obtain said product in the future at the same price regardless of inflation (Nilssen, C. 1, L. 39-40).

Williams and Nilssen does not specifically teach determining, during the second transaction and on behalf of the customer that a current price of the product is less then or equal to the second price (which is equal to the first price); and providing an indication based on the determining that the current price of the product is less then or equal to the second price that the benefit should be saved for a future transaction.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams and Nilssen to include recommending the customer, based on the determining that the current price of the product is less then

Art Unit: 3639

or equal to the second price that the benefit should be saved for a future transaction, because, based on common sense, one would not desire to pay more for something when it is possible to pay less, and this would be clearly understood by one of ordinary skill in the art.

Dependent Claims

As per claims 60-62, providing said customer a benefit identifier [0047].

As per Claims 82-84, see reasoning applied to Claim 81.

As per Claim 87, see reasoning applied to Claim 86.

Claims 5, 10, 34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Walker et al. (US 5,970,470).

Dependent Claims

As per claims 5, 10, 34 and 39, Williams teaches all the limitations of claims 5, 10, 34 and 39, except teaching imposing a penalty or reducing the benefit if a customer does not complete a specific future transaction.

Walker et al. (Walker) teaches a method for establishing and managing subscription purchase agreements, wherein a customer's account may be assessed a penalty in the event that the customer does not honor the purchase terms and conditions (C. 2, L. 63 – C. 3, L. 4).

It would have been obvious to one having ordinary skill in the art to modify Williams to include imposing a penalty if a customer does not complete a specific future transaction, as disclosed in Walker, because it would advantageously allow to minimize losses incurred by vendors who provide benefits for their customers.

Claims 26-27 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Mindrum et al. (US 4,723,212).

Dependent Claims

As per claims 26-27 and 45, Williams teaches all the limitations of claims 26-27 and 45, except that the benefit is transferable, and wherein said benefit can be shared by a plurality of people.

Mindrum et al. (Mindrum) teaches a method for dispensing discount coupons, wherein said coupons are distributed to different groups of customers (C. 1, L. 25-54).

It would have been obvious to one having ordinary skill in the art to modify Williams to include that the benefit is transferable and can be shared by a plurality of people, as disclosed in Mindrum, because it would advantageously attract new customers, thereby increase revenue.

Response to Arguments

Applicant's arguments filed 07/27/2006 have been fully considered but they are not persuasive.

In response to applicant's argument (A) that Williams describes providing coupons freely to customers and without charging customers for the coupons, and does not determine any price for the benefit, it is noted that Williams explicitly teaches that in order to receive said incentive, the customer has to conduct qualifying purchases, or *make in excess of a specified amount of purchases* from a specific retailer, or *by using a specified credit card each month* [0025], thereby indicating spending certain amount of money before receiving said incentives. As per term "freely", Examiner points out that the customers are not forced to accept said incentives, and do it on their own initiative.

Applicant further argues that Williams does not disclose that the price charged for the benefit is not the price that the customer is already paying to consummate the purchase. In response to applicant's argument, Examiner points out that the claim language: "wherein said price is a non-zero monetary amount that is different than the first transaction price" indicates only that the amount to be considered as qualifying amount can be different, for example less, than that which was already spent by the customer. While Williams does not explicitly disclose said difference in monetary

Art Unit: 3639

amounts, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that said benefit is different than the transaction price, because, based on common sense, there are only two choices available here, during said step of determining said price for said benefit. Said price is either equal to the transaction price, or different, and either choice is in the range of skill to arrive to for one of ordinary skill in the art.

In response to applicant's argument (B) that Williams fails to disclose that the price charged for the benefit is not the price that the customer is already paying to consummate the purchase, Examiner addresses to the discussion above for argument (A).

Applicant further argues that Nilssen does not disclose that the price charged for the benefit is not the price that the customer is already paying pursuant to transaction. In response to this argument it is noted that Nilssen was applied to show that said benefit comprises allowing said customer to purchase said product during said second transaction for said (first transaction) price (See discussion above). Furthermore, while Williams in view of Nilssen does not explicitly disclose said difference in monetary amounts, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams and Nilssen to include that said benefit is different than the transaction price, because, based on common sense, there are only two choices available here, during said step of determining said price for said benefit. Said price is either equal to the transaction price, or different, and either choice is in the range of skill to arrive to for one of ordinary skill in the art.

At this point Applicant appears to argue against the references individually; but one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding applicant's arguments (C) and (D), so as said arguments are essentially the same as arguments (A) and (B), reasoning applied to arguments (A) and (B) are equally applicable to arguments (C) and (D).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

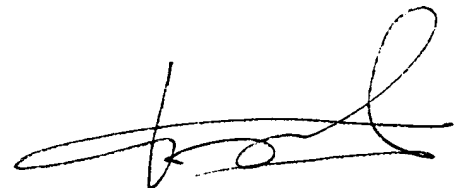
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 3639

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB
10/30/2006

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', with a stylized, flowing script.

IGOR N. BORISSOV
PRIMARY EXAMINER